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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Marlin

Serial No.: 09/704,771

Group: 3712

Filed: 11/03/2000

Examiner: Miller, B

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

AMENDMENT AND RESPONSE

Sir:

This is a response to the Office Action mailed 04/23/04. Applicant requests an interview with the examiner to discuss the above case.

IN THE CLAIMS

Please see the attachment

RESPONSE

The Office Action of May 5, 2003 has rejected claim 22 in light of Vaiani. Applicants respectfully disagree.

As noted in the Office Action:

“Vaiani teaches in the figures most of the elements of the claimed invention,

including a helical section (70), a handle being integral with said helical section, the handle comprising a straight section, and metal material.

In response, applicant notes the following.

Claim 22, as amended, reads as follows:

22) A flexible, retractable coiled toy comprising:

a single, unitary plastic wire having a circular cross section and having memory, said wire comprising:

- i) a helical section, said helical section ranging in length from about two and three-quarter inches to about six inches. and
- ii) a handle, said handle being integral with said helical section, said handle comprising a straight section of said wire extending outwardly from said helical section wherein said handle ranges in length from about 3 ½ inches to about 6 ½ inches.

The above described invention is not obvious in lieu of Vaiani.

Viaini's "coil" has a "tail" at both ends. In contrast, the present invention has a handle at one end, while at the other end, the coil merely ends. This is an important difference, because if the present invention had a tail at its opposite end, it would not be able to function as a lasso. In fact, if the coil had a tail at its distal end, it would be weighted down, and the drag created by the tail would prevent it from acting as a lasso.

Viani's coil also shows fasteners on both ends. The present invention does not have fasteners

at both ends. One end of the present invention has to be a handle; otherwise, the lasso function of the invention would not work.

Vaiani is a metal coated piece of steel. This device can not work if it is made of metal. Applicant cites to the video, which shows the incredible flexibility of the invention. No material, other than plastic, as designed in the shape described, can perform the tricks as those of the present invention.

Additionally, the coil of Vianni is much longer than that of the present invention. Th he Office states that it would have been "obvious to one having ordinary skill in the art ...to have made the helical section's lenght of Vaiani ranging from about 2 3/4" to about 6 1/2" since it is known in the art to have the helical section and handle between the claimed range for the purpose of grasping the end of the handle." However, the Office Action is missing the point of the dimensions of the present invention.

The dimensions of the present invention are specific such that the device is able to lasso objects, work as a belt, function as jewelry, or is able to perform any of the other tricks taught in the video and in the specification. Nowhere is it suggested in the Vaiani specification that his device has a specific size that allows it to perform these tricks. In fact, there is no motivation for Vaiani to reduce his device to the claimed sizes as his device could not perform said tricks, due to the important differences cited above.

It appears that in order to find obviousness, hindsight was used to bridge the gap between Vaiani's device and the present invention .

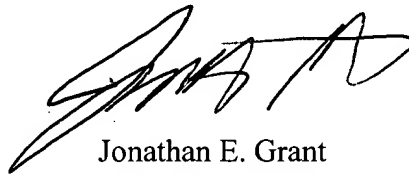
In ascertaining the differences between the prior art and the claims at issue (the second factual inquiry of *Graham v. John Deere*), it is essential to view the claims at issue as "the invention

as a whole,” as required by 103 and “without the benefit of hindsight vision afforded by the claimed invention.” *Hodosh v. Block Drug Co., Inc.* 786 F.2d 1136, 1143 n. 5, 229 182, 187 n. 5 (Fed. Cir. 1986). Similarly, it is essential to consider all elements of the claimed invention; it is impermissible to compare the prior art with what the viewer interprets the “gist” of the invention to be. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2D 888, 221 USPQ 669 (Fed. Cr. 1984). In *Jones v. Hardy*, 727 F.2d 1524, 1527-28, 220 USPQ 1021, 1024 Fed. Cir. 1984), the court held that reducing a claimed invention to an ‘idea’ and then determining patentability of the ‘idea’ is error.

Given the differences between the two devices, and given the amended claim, a finding of obviousness should be reconsidered, and the device should be found allowable.

Please call or fax me at (301) 603-9071 if you have any questions or comments.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jonathan E. Grant', is positioned above the printed name and registration number.

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